

REMARKS

The above amendment and these remarks are responsive to the Office action of Examiner Sean M. Reilly of 17 Jul 2006, designated FINAL.

Claims 1-106 are in the case, none as yet allowed.

35 U.S.C. 101

Claims 105-106 have been rejected under 35 U.S.C. 101 as directed to non-statutory subject matter.

In this rejection, the Examiner states that the claims fail "to embody the claimed program or program instructions on a storage medium... A computer program must be embodied on a storage medium in order to be statutory." [Office action, page 3.]

Applicants note that each of these claims recite "a tangible storage medium" and that "said first, second... program instructions are recorded on said tangible program storage medium." Applicants feel that in structuring the

claims in this manner, they have satisfied the requirement that the "computer program must be embodied on a storage medium".

Applicants urge that claims 105-106 be determined to be drawn to statutory subject matter under 35 U.S.C. 101.

35 U.S.C. 103

Claims 1-106 have been rejected under 35 U.S.C. 103(a) over Boe et al, 6,122,276 (Boe hereafter) and Chen et al. (U.S. Patent 6,182,220, hereinafter Chen), and claims 13-16, 21, 44-47, 83-86, and 100-103 have been rejected under 35 U.S.C. 103(a) over Boe and Murphy et al. (RVD 287, "5250 Telnet Enhancements" July 2000; hereinafter Murphy).

In responding to this rejection, applicants note that neither Murphy nor Chen negotiate a confirmation record, which is the first step in applicants process as claimed, and again note the following critical distinction between their claims and Boe. It is that Boe has an additional level of indirection not found in applicants' design.

Specifically, Boe has a TN3270 client (Fig. 1, element

13), a TN3270 server (Fig. 1, element 18), and also a legacy Host (Fig. 1, element 12). This means Boe has communications between the TN3270 client and the TN3270 server (as do applicants), but he also has communication between the TN3270 server and the legacy Host that is required during the negotiations of interest. (The system in which applicant's invention operates also has communication between the TN3270 server and a legacy Host, but these are irrelevant to the negotiations which are the subject of their claims.)

In Boe, all of the negotiations and communications of interest occur between the TN3270 server and the legacy Host. Applicants have no comparable communication link, as all of applicants' negotiations occur between their TN5250 client and TN5250 server. Specifically, the Confirmation Record payload represented by applicants' patent (Figure 2, element 122) is returned by the TN5250 server (Figure 3, element 42) to the TN5250 client (Figure 3, element 40).

Thus, when applicants teach passing back information in a Confirmation Record to the client, this information is actually communicated to the TN5250 client (Figure 3, element 40). In Boe's case, on the other hand, this

information is communicated from the legacy Host to the TN3270 Server, and it does not continue on to the actual TN3270 client.

This distinction is significant because the TN3270 client from Boe is not actually involved in any of the negotiations set forth in applicants' claims. In other words, Boe's TN3270 client is not able to act on any information from the "confirmation record", such that it could do retry processing using a different set of negotiation variables, or taking corrective action based upon the error code returned in the confirmation record. Since the goal of Boe is to enable the legacy Host to track clients (Col. 7, lines 8-12) in the TN3270 server (called the "communications gateway" by Boe), and since applicants invention relates to enabling programmable negotiations by the client, Boe is not, applicants assert, pertinent to applicants claims.

Applicants have amended the claims to recite the system environment as including a client, server, and legacy host, and that both client and server execute negotiations as exit programs for negotiating a confirmation record on the session request. [See Specification, page 4, line 1 ff, and

page 5, line 17ff.] By claiming, as is done in all independent claims, that negotiations are from client directly with the server it is implicit that such negotiations do not involve the legacy host.

With respect to claims 1, 18, 23, 32, 49, 58, 63, 71, 88, 105, and 106, the Examiner asserts that Chen teaches the elements of the claim, except for (1) a GUI selectively assigned a session name enabling client emulator communication at an application layer with the server, and (2) responsive to receiving a user variable requesting a custom confirmation record received at the server from the client, the server sending a confirmation record and custom record data enabling the client to engage in subsequent programmable negotiations directly with the server.

With respect to (1), the Examiner references Murphy, and with respect to (2), the Examiner references Boe.

Applicants traverse.

The Examiner refers to Boe, referring to host 12 as the server and TN3270 server 18 as the client. As previously

explained, these components of Boe do not meet the requirements of the server and client components of applicants' claims, and cannot be properly combined with Murphy and Chen to meet the requirements of applicants' independent claims 1, 18, 33, 32, 49, 58, 63, 71, 88, 105, and 106, nor of the claims depending therefrom.

The Examiner suggests as motivation for combining the Murphy, and Chen references,

"... Thus, it would have been obvious... to incorporate the virtual device name functionality as disclosed by Murphy within Chen's system, so that Chen's telnet server is able to identify all the parameters negotiated and allocated to a particular virtual device for a client's telnet session." [Office Action, page 6.

Applicants note that neither Chen or Murphy negotiate a confirmation record using such functionality.

Further, the Examiner suggests as motivation for combining the Boe and Chen references,

"...It would have been obvious... to incorporate the

telnet negotiation scheme disclosed by Boe within Chen's system, in order to further expand the compatibility of Chen's system, by enabling telnet clients to communicate with telnet servers that utilize the old proprietary SNA server protocol or protocols derived from the old proprietary SNA server protocol. Additionally Boe's negotiation scheme allows additional telnet capabilities to be negotiated and implemented and would thus increase the telnet capabilities and features of Chen's system.

In each instance, the Examiner has not identified any teaching in the art references that suggest the asserted combinations.

Thus, applicants traverse, and argue that the Examiner has not established a prima facie case of obviousness, which requires that the Examiner provides

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would

appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The fourth element of the prima facie case, the suggestion to combine, must come from the prior art. It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements. [See *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ 2d 1294 (Fed. Cir. 1997)]. That a claimed invention may employ known principles does not itself establish that the invention would have been obvious, particularly where those principles are employed to deal with different problems. [See *Lindermann*, supra.] The Examiner must consider the claim as a whole, and not piece together the claimed invention using the claims as a guide. The Federal Circuit has stated: "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. [See *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992)].

The Examiner must not only identify the elements in the prior art, but also show 'some objective teaching in the

prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). (Ex parte Rao S. Chintakrindi, Thomas E. Murphy, Paul F. Rieth and Jeffrey S. Stevens, Non-binding decision of the Board of Patent Appeals and Interferences, 9/30/2003 in Appeal No. 2001-2578, Application No. 08/977,547 filed 25 Nov 1997, END919970136US1.)

In the present case, applicants assert, the Examiner has used applicants' own teachings to find motivation for the combinations of references used in the rejection of the claims.

Applicants urge that claims 1-106 be allowed.

SUMMARY AND CONCLUSION

Applicants urge that the above amendments be entered and the case passed to issue with claims 1-106.

The Application is believed to be in condition for

allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Sincerely,

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By



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